

In the Office Action the Examiner rejected the claims under 35 U.S.C. 103 over the U.S. patent to Scott '562 in view of the U.S. patent to Scott '090 and further in view of the patent to Sims '550.

In the Examiner's opinion the present invention can not be considered as obvious from the combination of the references.

Before the analysis of the prior art, it is believed to be advisable to explain to the Examiner again the new features of the present invention.

The present invention deals with a device for information input and/or output, which has a processor and a display with a touch-sensitive layer. The display has operator control elements and information fields. The device is connected to a communications network by means of a communication module which is connected to the processor. The device is formed so that it fits into a frame that is suitable for a recessed and a surface-mounted socket.

In accordance with the new features of the present invention the operation control elements and information fields shown by the display are programmable. Also, the processor allows a configuration in which the processor offers configuration menus.

In his rejection of the claims the Examiner indicated that the feature "wherein the control elements and information field are programmable" is known from the patent to Scott, et al because it is well known to program these elements.

Applicant has to respectfully disagree with this position for the following reasons.

The Examiner's statement that it is well known to program these elements, namely the control elements and information fields, is just an assertion without any proof. The references do not disclose these new features of the present invention, and there is no prior art which discloses these elements. Programmable control elements and information fields are not well known in the art.

Furthermore, the patent to Simms only discloses user input of many selection "column 4, lines 41-53". However, it is silent about configuration menus.

Definitely, the prior art does not suggest the new features of the present invention. In order to arrive at the applicant's invention, the references have to be fundamentally modified by including into them the new features of the invention, for reasons which can not be considered as

obvious and in a way which also can not be considered as obvious since the modification has to be tailored so as to arrive exactly at the applicant's invention.

In connection with this, it is believed to be advisable to cite the decision in re Debus, (iv.App No.93-132, Slip op at 3 (Fed. Cir. Dec.10, 1993):

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification".

Definitely, it may be possible that the prior art may be modified in the manner suggested by the Examiner, however the prior art does not disclose any hint or suggestion, or any desirability for such modification or their desirability.

The Examiner expressed the opinion that it would have been obvious to provide the new features of the present invention, in the situation when these features have never been disclosed in the prior art or known for a person of ordinary skill in the art. In connection with this, it is also to be advisable to cite the decision in re W. L. Gore & Assocs., Inc. V. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983), in which it was stated:

"To imbue one of ordinary skill in the art with knowledge of

the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is respectfully submitted that the new features of the present invention are the features which only the inventor proposed, they are not disclosed in the prior art, the prior art does not provide any hint or suggestion for making these features obvious.

In view of the above presented remarks and amendments, it is believed that the claims currently on file should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Striker", with a long horizontal flourish extending to the right.

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